

REMARKS

Claims 1-14 are all the claims pending in the application. Claim 14 is added via the present Amendment.

INFORMATION DISCLOSURE STATEMENT:

The Examiner asserts that he does not have copies of the Japanese references submitted with the Information Disclosure Statement filed on July 1, 2004. For the Examiner's convenience, Applicants hereby submit copies of the noted references along with a clean version of the Substitute for Form 1449 A & B/PTO that was filed on July 1, 2004. The Examiner is respectfully requested to initial and return the Form to Applicants, indicating that the references have been considered.

35 U.S.C. § 102:

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Uchida et al. (U.S. Patent No. 6,833,641 [hereafter "Uchida"]).

Applicants respectfully submit that claim 1 is drawn to a novel and unobvious drive unit. To further define the claimed features, Applicants amend claim 1 to recite a thermally insulating intermediate member interposed between mating surfaces of the heat sink and the drive unit casing. Uchida fails to disclose each feature recited in amended claim 1.

Uchida discloses an electric drive unit that discharges working oil from oil reservoirs during periods of normal and low temperatures to cool an electric motor and provide lubrication. It is respectfully submitted that Uchida does not disclose the unique combination of features

recited in claim 1, including the thermally insulating intermediate member. This feature provides benefits and contributes to the unique combination of claimed features, for example, as noted in the present specification.

Accordingly, Applicants respectfully submit that Uchida fails to disclose each feature recited in claim 1, such that the rejection thereof under 35 U.S.C. § 102(e), should be withdrawn.

35 U.S.C. § 103:

Claims 1, 2, 4, 5, 7, 9, 10 and 12

Claims 1, 2, 4, 5, 7, 9, 10 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara et al. (U.S. Patent 6,323,613 [hereinafter "Hara"]) in view of Iverson et al. (U.S. Patent 6,002,183 [hereinafter "Iverson"]). To establish a *prima facie* case of obviousness, it must be shown that the prior art references, when combined, teach or suggest all of the claim limitations. The combination of Hara and Iverson does not teach or suggest each feature of claim 1.

Hara is cited for disclosing a drive unit including an electric motor, a drive unit casing, an inverter and a flow passage. The Examiner acknowledges that Hara fails to teach or suggest a heat sink comprising heat sink side fins extending into a space toward the drive unit casing, as recited in claim 1. The Examiner therefore turns to Iverson for disclosing a cooling structure having a heat sink with side fins.

Applicants respectfully submit that even if there were, *arguendo*, motivation to combine the teachings of Iverson with Hara, the combination of claimed features would not be taught or suggested.

For example, claim 1 recites, *inter alia*, a thermally insulating intermediate member interposed between mating surfaces of the heat sink and the drive unit casing. Applicants respectfully submit that the applied art, in combination or taken singularly, fails to teach or suggest each of the recited features, including the thermally insulating intermediate member.

Applicants therefore respectfully submit that Hara and Iverson fail to teach or suggest each feature found in claim 1, such that the rejection thereof under 35 U.S.C. § 103(a) should be withdrawn. The rejection of dependent claims 2, 4, 5, 7, 9, 10 and 12 should likewise be withdrawn at least by virtue of these claims respectively depending from claim 1.

Claims 3, 6, 8, 11 and 13

Claims 3, 6, 8, 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara in view of Iverson and further in view of Lopatinsky et al. (U.S. Patent 6,664,673 [hereinafter "Lopatinsky"]).

Lopatinsky is applied for allegedly disclosing a cooling structure for an electric machine that has pin-shaped fins. The combined references fail to teach or suggest each feature of claim 1. In particular, the application of Lopatinsky fails to make up for the deficient teachings of Hara and Iverson regarding at least the claimed thermally insulating intermediate member, such that claims 3, 6, 8, 11 and 13 are patentable over the combined references at least due to their respective dependencies upon claim 1.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No.: 10/500,581

Attorney Docket No.: Q81943

NEW CLAIM:

Applicants add new claim 14 to obtain more varied protection for the invention. It is respectfully submitted that claim 14 is patentable over the applied art at least by virtue of its dependency upon claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

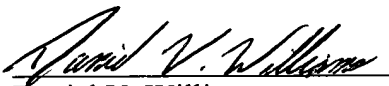
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